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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,163	05/23/2000	Kia Silverbrook	NPS003US	9191

24011 7590 03/02/2004

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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DHARIA, PRABODH M

ART UNIT	PAPER NUMBER
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2673

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DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/575,163

Applicant(s)

SILVERBROOK ET AL.

Examiner

Prabodh M Dharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>03-07-2001</u> . | 6) <input type="checkbox"/> Other: _____  |

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because the abstract is using legal phraseology "means" in lines 4-7 and "said" in lines 5,6,8,9. The "(figure 8)" recited in the bottom of the abstract also needs to be deleted as well as "said" and "means" needs to be deleted from the abstract. Correction is required. See MPEP § 608.01(b).

***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,679,420B1 in view of claims 1-55 of U.S. patent No. 6,681,045 B1 and claims 1-46 of U.S. patent No. 6,678,499 B1.

6. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

a system for transferring data from a portable data capturing device to a data processing means, the system comprising: a wireless communications means for transmitting data from said data capturing device to the data processing means, the wireless communications means comprising a transmitter in communication with said data capturing device and a receiver in communication with the data storage means, the transmitter having a finite transmission range; and a buffer in communication with said data capturing device for temporarily storing at least some of the data captured by the said data capturing device, wherein data which is temporarily stored in the buffer is only transmitted to the receiver when the receiver is located within the transmission range of the transmitter.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1,4,6,8-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Price et al. (5,561,282).

Regarding Claim 1, Price et al. teaches a system for transferring data (Col. 29, Lines 60,61) from a portable data capturing device (Col. 30, Lines 1,2) to a data processing means (Col. 29, Lines 59-64), the system comprising: a wireless communications (Col. 29, Lines 60-62) means for transmitting data from said data capturing device to the data processing means (Col. 29, lines 59-64), the wireless communications means comprising a transmitter in communication with said data capturing device and a receiver in communication with the data storage means (Col. 29, lines 59-64), the transmitter having a finite transmission range (Col. 31, Lines 41-53, Col. 9, lines 19-30, Col. 33, Lines 40-46); and a buffer in communication with said data capturing device for temporarily storing at least some of the data captured by the said data capturing device (Col. 33, Lines 53-60), wherein data which is temporarily stored in the buffer is only transmitted to the receiver when the receiver is located within the transmission range of the transmitter (Col. 33, Lines 61-66, Col. 9, Lines 31-42, Col. 8, lines 30-43).

Regarding Claim 4, Price et al. teaches a range detection means for detecting when the receiver is out of transmission range of the transmitter (Col. 31, Lines 41-53, Col. 9, lines 19-30, Col. 33, Lines 40-46).

Regarding Claim 6, Price et al. teaches an out-of-range indicator at the location of the data capturing device for indicating to a user when the receiver is outside the transmission range (Col. 31, Lines 41-53, Col. 9, lines 19-30, Col. 33, Lines 40-46).

Regarding Claim 8, Price et al. teaches the data capturing device is adapted to capture coded data recorded on a surface (Col. 35, Lines 10-26).

Regarding Claim 9, Price et al. teaches the coded data is optically encoded on the surface (Col. 35, Lines 10-26, Col. 31, Lines 45-49).

Regarding Claim 10, Price et al. teaches the data capturing device (Col. 30, Lines 1,2) comprises a sensing device for sensing region (Col. 25, Lines 9-11) identity data (Col. 35, Lines 10-26) and generating movement data when the sensing device is moved relative to a region of a surface, the region identity data being indicative of an identity of the region (Col. 20, Lines 45-49, Lines 26-30, Col. 25, Lines 10-22), the movement data being indicative of the movement of the sensing device relative to the region (Col. 25, Lines 16-23), the surface having disposed upon it coded data indicative of at least one region associated with the surface, the sensing device including: region identity sensing means configured to sense the region identity data using at least some of the coded data (Col. 35, Lines 10-26, Col. 25, Lines 40-54) , motion sensing means configured to generate the movement data; and communications means configured to communicate the region identity data and the movement data to a computer system (Col. 25, Lines 10-44, Col. 35, Lines 10-26).

Regarding Claim 11, Price et al. teaches the motion sensing means is configured to generate the movement data using at least some of the coded data (Col. 19, Lines 10-41, Col. 20, Lines 12-21, Col. 24, Lines 65-67, Col. 35, Lines 10-26).

Regarding Claim 12, Price et al. teaches the coded data is also indicative of a plurality of reference points of the region, the motion sensing means being configured to generate the movement data on the basis of the sensing device's movement relative to at least one of the reference points (Col. 19, Lines 10-44).

Regarding Claim 13, Price et al. teaches the coded data includes periodic elements, the motion sensing means being configured to generate the movement data on the basis of the sensing device's movement relative to at least one of the periodic elements (Col. 19, Lines 10-41, Col. 20, Lines 12-21, Col. 24, Lines 65-67, Col. 35, Lines 10-26).

Regarding Claim 14, Price et al. teaches the motion sensing means is configured to sample the position of the sensing device relative to the at least one reference point or periodic element, thereby to generate the movement data (Col. 19, Lines 10-44).

Regarding Claim 15, Price et al. teaches the movement sensing means includes at least one acceleration sensing means, the acceleration sensing means being configured to sense acceleration of the sensing device as it is moved relative to the surface region, the movement

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sensing means being configured to generate the movement data by periodically sampling the acceleration (Col. 19, Line 63 to Col. 20, Line 8).

Regarding Claim 16, Price et al. teaches the sensing device is in the form of a stylus or pen (Col. 19, Lines 23-29).

Regarding Claim 17, Price et al. teaches a force sensing means configured to sense a force applied to a surface by the sensing device, and for providing force data corresponding to the force applied (Col. 19, Lines 10-44).

Regarding Claim 18, Price et al. teaches the receiver is in transmission range, data stored in the buffer is transmitted to the receiver each time the force sensing means senses that contact between the data capturing device and the surface has been broken (Col. 20, Lines 4-30).

Regarding Claim 19, Price et al. teaches a system for transferring data (Col. 29, Lines 60,61) from a portable data capturing device (Col. 30, Lines 1,2) to a data processing means (Col. 29, Lines 59-64), the system comprising: a wireless communications (Col. 29, Lines 60-62) means for transmitting data from said data capturing device to the data processing means (Col. 29, lines 59-64), the wireless communications means comprising a transmitter in communication with said data capturing device and a receiver in communication with the data storage means (Col. 29, lines 59-64), the transmitter having a finite transmission range (Col. 31, Lines 41-53, Col. 9, lines 19-30, Col. 33, Lines 40-46); and a buffer in communication with said data



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capturing device for temporarily storing at least some of the data captured by the said data capturing device (Col. 33, Lines 53-60), wherein data which is temporarily stored in the buffer is only transmitted to the receiver when the receiver is located within the transmission range of the transmitter (Col. 33, Lines 61-66, Col. 9, Lines 31-42, Col. 8, lines 30-43).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2,3,5,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Price et al. (5,561,282) as applied to claims 1,4,6,8-19 above, and further in view of Clark (5,815,577).

Regarding Claim 2, Price et al. teaches the buffer has a finite buffer storage capacity; the arrangement being such that when the buffer is filled to storage capacity, the data capturing means ceases capturing data (Col. 33, Lines 53-60).

However, Price et al. fails to teach specifically a finite buffer storage capacity, the arrangement being such that when the buffer is filled to storage capacity, the data capturing means ceases capturing data

However, Clark teaches the buffer has a finite buffer storage capacity, the arrangement being such that when the buffer is filled to storage capacity, the data capturing means ceases capturing data (Col. 16, Lines 19-62).

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Thus it is obvious to one in the ordinary skill in the art at the time of invention was made to incorporate Clark teaching in teaching of Price et al. to be able to display high precisely and brightly image.

Regarding Claim 3, Clark teaches an alarm signal (flag signal) is generated to alert a user when the buffer is filled to storage capacity (Col. 16, Lines 19-62).

Regarding Claim 5, Clark teaches a controller for controlling operation of the buffer and the transmitter (Col. 16, Lines 19-62).

Regarding Claim 7, Clark teaches an encryption means for encrypting data before the data is transmitted (Col. 2, Lines 50-56).

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is informed that all of the other additional cited references either anticipate or render the claims obvious. In order to not to be repetitive and exhaustive, the examiner did draft additional rejection based on those references.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Black (6, 539, 101 B1) Method for Identity Verification..

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prabodh M Dharia whose telephone number is 703-605-1231.

The examiner can normally be reached on M-F 8AM to 5PM.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on 703-3054938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

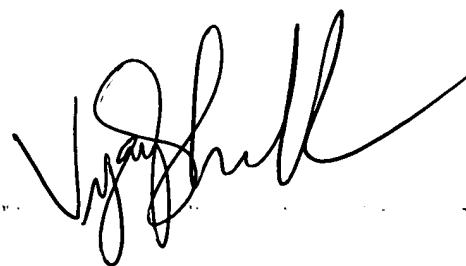
Commissioner of Patents and Trademarks

Washington, D.C. 20231

PD

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February 24, 2004



**VIJAY SHANKAR**  
**PRIMARY EXAMINER**